

Atty Docket No.: 200206420-1

Remarks

This communication is responsive to the Office Action of November 2, 2007. Reexamination and reconsideration of claims 1-17, and 20-36 is respectfully requested.

Summary of The Office Action

The Title of the application was identified as being "not descriptive". A new title has been provided.

Claims 1, 4-6, 8-10, 17-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ashley Patent No. (US 6,909,992 B2)(Ashley) and further in view of Van Der Meijjs (Pub. No. US 2002/0122204 A1)(Van Der Meijjs). Claims 18 and 19 have been cancelled.

Claims 2-3 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ashley as applied to claim 1 and 6, and further in view of Zintel et al. (Patent No. 7,130,895 B2)(Zintel).

Claims 23-27, 28-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ashley, as applied to claim 1 and 8, and further in view of Grover et al. (Patent No. 7,155,497 B2)(Grover). Claims 31 and 37 have been cancelled.

Claims 11-16, 19, 22 were rejected "by reference" to other claims. The Office Action asserts that "claim 11 is the same as claim 1, claim 12 is the same as claim 5, claim 13 is the same as claim 6, claim 14 is the same claim 7, claim 15 is the same as claim 8, claim 16 is the same as claim 9, claim 19 is the same as claim 3 (and) claim 22 is the same as claim 12.

Atty Docket No.: 200206420-1

The Claims Patentably Distinguish Over the References of Record

35 U.S.C. §103

Claims 1, 4-6, 8-10, and 17-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ashley and further in view of Van Der Meijs (VDM). Claims 2-3 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ashley as applied to claim 1 and 6, and further in view of Zintal. Claims 23-27, 28-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ashley, as applied to claim 1 and 6, and further in view of Grover.

To establish a prima facie case of 35 U.S.C. §103 obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP 2143.01. Second, there must be a reasonable expectation of success. MPEP 2143.02. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.03. Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This requirement is intended to prevent unacceptable "hindsight reconstruction" where Applicant's invention is recreated from references using the Application as a blueprint.

Here, the third criteria described in MPEP 2143.03 is not satisfied since the combination of references does not teach or suggest all the claim limitations. None of the references, alone and/or in combination, teach storing the address of a configuration server, a posting server, and/or a communication server. Therefore, it follows that none of the references teach communicating setup data between an image forming device and a server whose address is not stored. Therefore, it also follows that none of the references teach automatically configuring an image

Atty Docket No.: 200206420-1

forming device to process alerts based on the setup data that is not communicated. Thus, none of the claims are obvious for at least this reason.

Ashley

Ashley describes using a count down monitor to automatically generate an alert that an item in a computer system(s) is due for replacement. (Abstract) In particular, Ashley concerns "automatically identifying replacement times of limited lifetime components." Col. 1, lines 9-10. The limited lifetime components may include filters, batteries, and so on. Col. 1, line 42. Ashley describes how "a generated alert may be sent to an application when a count down interval elapses." Col. 2, lines 23-24. Thus, Ashley clearly describes sending alerts, but manages to not teach any of the claimed elements.

Ashley does not teach storing the address of a server associated with configuration. Instead, Ashley describes where "system configuration data" can be stored. But "system configuration data" does not include the claimed addresses. Column 4, lines 48-63 describe that "system configuration" data 140 includes configuration information for several different computer systems 101A and 101B. Each computer system's configuration information 140A and 140B may include one or more objects (e.g., files, documents and/or database records). Various types of data may be included with each computer system's configuration information. For example, the configuration information for one computer system may include digital photos of the physical layout of the components within that computer system, data files listing the hardware and/or software components included in that computer system, database records indicating the service history for one or more components included in that computer system, text documents that include customer contact information for that computer system, files identifying service personnel assigned to that computer system, etc." This passage, and indeed all of Ashley, is silent concerning storing the address of a server associated with configuring the image forming device to process alerts. System configuration data

Atty Docket No.: 200206420-1

is further described at Column 5, lines 17-26, but once again fails to include the stored address.

Ashley also fails to teach the setup logic. No configuration server address is stored in the data store. Therefore there is no location to which setup data can be communicated. Since there is no location to which setup data can be communicated, it follows that there is no setup logic to communicate that data.

The Office Action acknowledges that Ashley "does not teach the specifics of configuring an image forming device." Page 4, lines 11-12. This is correct but incomplete with respect to the claimed subject matter. The claim recites a configuration logic to "automatically configure the image forming device to process alerts." The Office Action asserts that VDM combined with Ashley makes claim obvious. This is incorrect.

Van Der Meels (VDM)

VDM teaches "a method of configuring a printer... wherein a set of print parameters is stored in the control unit of a the printer." Abstract. Printer parameters include, for example, "voltages with which individual nozzles of an inkjet nozzle head or the individual LEDs of a laser printer are to be energized." Column 1, [0005]. These printing parameters, while useful, are not related to processing alerts. VDM does not provide the missing stored server addresses, the missing setup logic, or the missing configuration logic.

The combination of Ashley and VDM would be a printer that could receive printer parameters from another device over the Internet and that could generate pre-defined, manually configured alerts associated with batteries wearing out and filters needing replacement, and so on. The combination does not teach automatically configuring a printer to generate alerts and thus does not teach storing the address of a configuration server, posting server, and/or communication server involved in processing the alerts. Since no server addresses are stored, it follows that the combination of references does not teach a setup logic that communicates setup information between the missing components.

Atty Docket No.: 200206420-1

Claims will now be discussed individually.

Independent Claim 1

This claim is directed to a computer readable medium (CRM). The CRM stores processor executable components and processor readable data that are used to configure an image forming device (e.g., printer) to process alerts. The CRM includes a data store to store an address of a configuration server, a posting server, and/or a communication server. These servers are used to configure the image forming device and to handle alerts generated by the image forming device. These devices tell the image forming devices what alerts to generate and where to send them. Alternatively, these devices may receive information from the image forming device about what alerts it will generate and to whom they are to be sent. To the extent that either of the references teaches configuration, it teaches one time configuration to establish a setting in a printer. The setting is unrelated to the ongoing distribution of alerts.

The CRM also includes a setup logic that communicates setup data for configuring the image forming device and/or the configuration server. The address of the configuration server is stored in the CRM. Neither of the references teaches communicating this setup data because neither reference teaches storing the address of the server. In both Ashley and VDM, data is pushed into a printer and the printer performs according to the received data. The location of a printer to which data is to be pushed may be stored somewhere, but the address of the three servers does not appear to be stored because of the one-time push model employed by the references.

The claim recites communicating setup data and then configuring the image forming device to process alerts based on that data. Thus the CRM includes a

Atty Docket No.: 200206420-1

configuration logic that automatically configures the image forming device to process alerts. The alerts are processed by the image forming device, the posting server, and/or the communication server. How the alerts are processed depends on the setup data communicated by the setup logic. Since none of the references teach communication of the setup data to a device whose address is stored in the CRM, it follows that none of the references teach the claimed configuration logic.

Since this claim recites features not taught or suggested by the reference, it patentably distinguishes over the reference. Accordingly, dependent claims 2-10 also patentably distinguish over the reference and are in condition for allowance.

Dependent Claim 4

This claim depends from claim 1 and thus is not obvious for at least the same reasons. Additionally, this claim recites a posting logic that selectively communicates posting data with a posting server. The communication is controlled by the setup data.

The Office Action asserts that Ashley teaches the posting logic at column 3, line 57. This passage merely describes a computer that has a cpu and i/o interfaces. It is silent concerning any of the claimed elements or limitations. Similarly column 14, line 27 merely recites how an application server can support a protocol that enables communication via server commands. It too is silent concerning any of the claimed elements or limitations. Likewise, column 10, line 13 merely recites how web application security may be considered at different levels, including client-to-server communications. Once again this is silent concerning any of the claimed elements or limitations. Indeed, none of the cited passages nor any portion of Ashley or VDM describe the posting logic, the posting server, or storing the address of the posting server in the data store. For this additional reason this claim is not obvious and is in condition for allowance.

Dependent Claim 5

Atty Docket No.: 200206420-1

This claim depends from claim 1 and thus is not obvious for at least the same reasons. Additionally, this claim recites selecting a posting server and a communication server. Since neither Ashley nor VDM teach interacting with either of these servers, it follows that neither teaches selecting which of the missing servers to interact with. For this additional reason this claim is not obvious and is in condition for allowance.

Dependent Claim 3

This claim depends from claim 1 and thus is not obvious for at least the same reasons. Additionally, this claim recites the configuration logic associating an alert with a device event. Since neither Ashley nor VDM teach the configuration logic, it follows that neither teaches the configuration logic performing this additional step. The combination of references teaches generating pre-defined events from a printer whose print parameters can be downloaded from the Internet. The claim recites a step that facilitates dynamic configuration where the combination of references only supports pre-defined static alerts. For this additional reason this claim is not obvious and is in condition for allowance.

Independent Claim 11

This claim was rejected "by reference" to claim 1. Thus, claim 11 is not obvious for at least the same reasons as claim 1. Additionally, while claim 1 and claim 11 share elements, claim 1 is a CRM while claim 11 is limited to being an ASIC. Neither of the references appear to teach an ASIC that includes the claimed data store, setup logic and configuration logic. Thus, for this additional reason this claim is not obvious and is in condition for allowance.

Independent Claim 12

This claim was rejected "by reference" to claim 5. While claims 12 and 5 share some elements, there are differences between the claims making the rejection by reference inappropriate. For example, claim 12 recites a selection

Atty Docket No.: 200206420-1

logic that will select a posting server, that will automatically configure the image forming device to post posting data, that will select a communication server, and that will automatically configure the image forming device to direct the posting server to utilize the selected communication server. While there are similarities between these elements, they are not identical, making the rejection by reference inappropriate and thereby not providing Applicant with adequate opportunity to advance prosecution.

Additionally, this claim recites elements not disclosed in any of the references and thus this claim is not obvious and is in condition for allowance. Accordingly, claims 13-17, which depend from claim 12, are likewise not obvious and are in condition for allowance.

Amended Independent Claim 20

This claim has been amended to include the original independent claim 18. This claim recites an image forming device memory that stores the address of a configuration server, posting server, and/or communication server. None of the references teach storing this address in an image forming device.

This claim also recites a setup logic in the image forming device. The setup logic resides in the alert configuration logic and the alert configuration logic resides in the image forming device. None of the references teach a setup logic in the image forming device. To the extent that any of the references teach a setup logic, that setup logic would reside outside the image forming device. The setup logic communicates setup data. Since the setup logic resides in the image forming device, the setup data is being communicated out of the image forming device. To the extent that any of the references teach communicating setup data, that data is pushed to the image forming device.

The Office Action asserts that the image forming device setup logic is taught by Ashley at column 3, line 39, column 4, line 64, and figure 8. However, none of these passages and figures, or any portion of Ashley, teach the setup logic being located in the image forming device.

Atty Docket No.: 200206420-1

Since this claim recites elements not found in the combination of references, the claim is not obvious and is in condition for allowance. Accordingly claims 21 and 22, which depend from claim 20, are similarly not obvious and are in condition for allowance.

Claims 23-27, and 28-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ashley, as applied to claim 1 and 6, and further in view of Grover.

Independent Claim 23

Claim 23 recites a method that includes automatically selecting a posting server based on startup data communicated from a starting up image forming device. This claim also recites automatically selecting a communication server based on the startup data. The claim also recites automatically configuring an image forming device to direct the posting server to employ the communication server to distribute an electronic notification.

Ashley describes manually configuring a device to provide an alert (e.g., email, fax) when a system resource is about to expire. The device does not appear to broadcast startup information that is used to identify network elements (e.g., posting server, communication server) involved in delivering alerts. Ashley appears to describe a system where an receiver of an alert is predefined in the manually configured device.

Grover describes "techniques for configuring network parameters to a device." Abstract. The "network parameters include a network address". Abstract. The network address is sent to a device to be configured by a configuring machine. The device to be configured claims the address and thereafter communicates using that address. Abstract.

Neither Ashley nor Grover describes selecting a posting server or a communication server. The combination of Ashley and Grover produces a device that can have an IP address pushed to it for its own use. The combination is silent

Atty Docket No.: 200206420-1

concerning providing startup data upon which posting server and communication server decisions can be made.

Since this claim recites elements not found in the combination of references, the claim is not obvious and is in condition for allowance. Accordingly claims 24 through 27, which depend from this claim, are similarly not obvious and are in condition for allowance.

Independent Claim 28

This claim recites a computer readable medium storing instructions for performing the method of claim 23. Thus, this claim is not obvious for at least the same reasons as claim 23.

Independent Claim 29

The Office Action provides no detailed rejection of claim 29. Instead, claim 29 is grouped together with an omnibus rejection of claims 23-27 and 28-37. This does not provide Applicant with adequate opportunity to advance prosecution. While claim 29 shares some actions with claim 23, it includes the additional action of negotiating a level of automatic configuration service for a printer. Neither Ashley nor Grover describe this additional action of negotiating the level of configuration service. Thus, for this additional reason this claim is not obvious and is in condition for allowance. Accordingly, claim 30, which depends from this claim, is similarly not obvious and is in condition for allowance.

Independent Claim 32

This claim concerns a data packet used to transmit data between an image forming device and an alert configuration server. None of the references describe the alert configuration server. Ashley describes manual configuration of alert settings. Grover describes pushing an IP address to a device. The combination of references would be an alert-enabled device that receives its IP address from another device over a network. While a useful device, this device does not teach

Atty Docket No.: 200206420-1

the claimed data packet and its elements. In particular, at no point is the address of an alert configuration server transmitted. To the extent that any of the references teach an alert configuration server, that server would have a predetermined address that is used but not transmitted. Additionally, none of the references describe using a posting server or a communication server. Therefore it follows that no data packet that includes fields for storing the addresses of the unmentioned servers is described.

For at least these reasons this claim is not obvious and is in condition for allowance.

Independent Claim 33

This claim recites an image forming device that includes an alert logic that transmits alert data using a communication server by way of a posting server. Which communication server is used depends on processing performed by a setup logic and a configuration logic. Ashley describes a computer that can send an alert. The address(es) to which the alert is sent appear to be manually configured and fixed. Additionally, distribution appears to be singly routed, where the destination address is coded directly into the computer. The claimed image forming device relies on a pair of servers, a posting server and a communication server. Neither of the references describe this combination of servers. Therefore it follows that the combination of references fails to teach an image forming device that can be configured and reconfigured with different communication server addresses accessible through a posting server.

Since this claim recites elements not found in the combination of references this claim is not obvious and is in condition for allowance. Accordingly claims 34-36, which depend from this claim, are similarly not obvious and are in condition for allowance.

Atty Docket No.: 200206420-1

References Cited But Not Applied

The references cited but not applied have been considered and do not teach or suggest the recited features of the respective claims, individually or in combination with each other. Therefore, all claims are in condition for allowance.

24

PAGE 25/26 * RCVD AT 1/30/2008 10:58:36 AM [Eastern Standard Time] * SVR:USPTO-EFAXRF-4/7 * DNIS:2738300 * CSID:12165035401 * DURATION (mm-ss):05-56

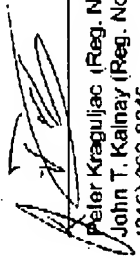
BEST AVAILABLE COPY

Atty Docket No.: 200206420-1

Conclusion

For the reasons set forth above, claims 1-17, and 20-36 are in condition for allowance. An early allowance of the claims is earnestly solicited.

Respectfully submitted,



Peter Kraguljac (Reg. No. 38,620)
John T. Kalnay (Reg. No. 46,816)
(216) 308-3245

Kraguljac & Kalnay, LLC
Summit One, Suite 510
4700 Rockside Road
Independence, OH 44131

BEST AVAILABLE COPY